

### **REMARKS**

Claim 70 has been cancelled. Claims 2-3, 7-9, 11, 13-18, 27-33, 40 and 68-69 remain in the application. Applicant asserts that no new matter has been added. Reconsideration of the Application is hereby requested.

### **Objections to the Claims**

**Claims 13-17** were objected to for depending from a cancelled claim. In response thereto, Applicant has amended these claims so as to depend from Claim 68. For this reason, Applicant believes that this objection has been overcome and respectfully requests that it be withdrawn.

### **Claim Rejections**

#### ***Rejections Under 35 U.S.C. § 112***

**Claims 27, 68 and 69** were rejected under 35 U.S.C. § 112, as being indefinite. In response thereto, Applicant has amended the independent claims to delete reference to the term “objective factor”; Applicant has also added the limitations directed using the promoter server computer to calculate a bounty to be paid to an advertiser based on objectively measured factors relating to the actual behavior of users.

The newly added claim language recites that the bounty is calculated by subtracting from a maximum bounty a product of an average frequency of actions performed by users of the opt-in system minus an average frequency of similar actions performed by users not opting-in to the disclosed opt-in system. These new limitations are supported in the Specification in, for example, ¶¶[0051]-[0062].

While these new limitations do not recite the exact formula disclosed in ¶[0051] *et seq.*, they recite subject matter with a reasonable degree of particularity and distinctness. The Examiner “should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness.” MPEP 2173.02 (emphasis in original). One of ordinary skill in the art, upon reading the amended claims in view of the Specification, would be able to understand their scope with “a reasonable degree of particularity and distinctness.” Therefore, the claims fit well with the guidelines set forth in MPEP 2173.02 for allowing them under §112, second paragraph.

Also, while the new limitations make the claims reasonable broad, “[b]readth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.” MPEP 2173.04. The scope of the subject matter embraced by the claims is clear and Applicant has disclosed in the Specification the best mode and preferred embodiment at the time of filing. Furthermore, Applicant has provided no indication of intent that the invention be broader than the scope of the claims. Therefore, the claims fit well with the guidelines set forth in MPEP 2173.04 for allowing them under §112, second paragraph.

Furthermore, “[a]s long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied.” MPEP 2164.01(b), See, also, *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). In the present case, the Specification clearly “discloses at least one method for making and using the claimed invention” and that method clearly “bears a reasonable correlation to the entire scope of the claim[s]” Therefore, the claims fit well with the guidelines set forth in MPEP 2164.01(b) for allowing them under §112, second paragraph.

For these reasons, it is believed that the amendments to the independent claims have

overcome the rejection under §112 and, therefore, Applicant respectfully requests that it be withdrawn.

***Rejections Under 35 U.S.C. § 101***

**Claims 27, 68 and 69** were rejected under 35 U.S.C. § 101, based on the Supreme Court's decision in *In re Bilski* 88 USPQ 2d 1385 (2008) (*cert.* granted June 1, 2009) and related Federal Circuit decisions. In response thereto, Applicant has amended each of these claims so that they positively recite the particular machine ("the promoter server computer") specifically architected to execute the method actions recited in the claims.

As can be seen in FIG. 1B and in ¶[0029], Applicant has enabled the "promoter server computer" to be a machine having a architecture (item 150) specifically adapted to execute the operations recited in the amended claims. Thus, the method steps recited in the claims, as presently amended, are now tied to a specific machine and such tying is supported in the Specification. It is now clear that the amended claims recite a method for a specifically architected promoter server computer to present opt-in windows to users, gain information valuable to advertisers from the responses to the opt-in windows and calculate a bounty to be charged to the advertisers based on the value to the advertisers of the computer-executed method. The amended claims are now clearly tied to a particular machine according to the standards set forth in *In re Bilski* and, for this reason, Applicant believes that this rejection has been overcome and respectfully requests that it be withdrawn.

***Rejections Under 35 U.S.C. § 103***

**Claims 7, 9, 27, 68 and 69** were rejected under 35 U.S.C. § 103(a), as being unpatentable over Frengut in view of Szabo in view of Detrick.

The presently amended claims recite a method by which a bounty charged to the

advertiser is based on the actions of the targeted users in comparison to actions of similar users not being tied into the opt-in system. Specifically, the claims recite limitations in which the maximum bounty is discounted by a factor that employs such a comparison. Thus, the bounty paid is based on actual activities of the users in comparison to users not part of the system.

The Action correctly admits that Frengut does not disclose billing the advertiser an amount that is determined by subtracting from a predetermined maximum bounty a product of the maximum bounty times an objective factor (please note, the previous “objective factor” limitations have been deleted and have been replaced by more detailed limitations relating to the way the bounty is determined). The Action also asserts that Szaabo discloses this element.

However, the cited paragraph (col. 28, ll. 4-16) of Szabo states only that a higher ad rate is charged based on “demographically targeted advertising” that employs predicting the ad response rate based on demographic factors. Nowhere does Szabo disclose a bounty calculating system in which a maximum bounty is multiplied by any sort of discounting factor, much less a factor that is determined by comparing opt-in users to users who have not opted-in.

These limitations are also not disclosed in Detrick. While Detrick discloses a system in which a “highest fee” is either paid or not paid based on the basis of the percentage of variables relating to the consumer are satisfied. Detrick only discloses a system the pays either a “highest fee” or one other fee (which in the only example give is nothing). (*See*, Detrick, col. 5, l. 38-53). Thus, Detrick discloses only a binary billing system in which the advertiser pays one fee if a sufficient number of variables are met and another fee (e.g., as zero) if less than the sufficient numbers of variables are met.

There is certainly nothing in Detrick that discloses a method of billing advertisers according to a sliding scale, as is done according to the present invention. This is significant because use of an all-or-nothing billing system (such as the one disclosed in Detrick) can expose the company managing the system to a substantial amount of risk, whereas a sliding scale system (such as the one recited in the amended claims) ensures both fair billing of advertisers and fair payment to the managing company based on performance.

Also, nothing in Detrick discloses variables relating to actual behavior of the users targeted in the advertising. Detrick certainly does not disclose a method in which actual behavior of users is used to calculate the bounty to be paid by advertisers. However, the actual behavior of users is much more valuable to advertisers than predictions of how users might behave in the future.

Finally, while Detrick indicates that the fees paid might be less than a maximum fee, Detrick does not disclose the manner in which the maximum fee is reduced. There is certainly no disclosure in Detrick of a system in which a bounty is determined by taking subtracting from the maximum bounty a factor that is based objectively the on actual behavior of the users of the claimed system in comparison with how users behave on other systems.

For this reason it is believed that this rejection has been overcome and Applicant respectfully requests that it be withdrawn.

**Claims 2-3, 17-18 and 32-33** were rejected under 35 U.S.C. § 103(a), as being unpatentable over Frengut in view of Szabo in view of Detrick in view of French et al US Pat No: 6,282,658.

French does not teach or suggest the limitations added in the claims from which Claims 2-3, 17-18 and 32-33 depend. Therefore, Applicant believes that this rejection has been overcome and respectfully requests that it be withdrawn.

**Claims 13-15 and 28-30** were rejected under 35 U.S.C. § 103(a), as being unpatentable over Frengut in view of Szabo in view of Detrick in view of Brierley et al, US Pub No: 2002/0161779.

**Claims 13-15 and 28-30** were rejected under 35 U.S.C. § 103(a), as being unpatentable over

Frengut et al. in view of Brierley et al, US Pub No: 2002/0161779.

Brierley teaches only the collection of data to provide “selection criteria for a future promotion.” (§[0079]) Thus, Brierley teaches only to assemble data to decide where to direct future promotions. It completely fails to use such data in determining how much to bill an advertiser. Thus, the combination of Brierley with Frengut still would not result in the present invention.

For this reason, Applicant believes that this rejection has been overcome and respectfully requests that it be withdrawn.

**Claims 11 and 40** were rejected under 35 U.S.C. § 103(a), as being unpatentable over Frengut et al.

Nothing in the Official Notice would indicate that a combination of the Official Notice with any of the other cited references would teach or suggest the predictive billing system recited in the amended independent claims.

For this reason, Applicant believes that this rejection has been overcome and respectfully requests that it be withdrawn.

**Claims 16 and 3** were rejected under 35 U.S.C. § 103(a), as being unpatentable over Frengut in view of Szabo in view of Detrick in view of Koningstein US Pub No: 2005/0096979.

Koningstein teaches only selection of a maximum cost per click in a click-based billing system. (See, e.g., §[0081]) Nothing in Koningstein would indicate that a combination of the Official Notice with any of the other cited references would teach or suggest the predictive billing system recited in the amended independent claims.

For this reason, Applicant believes that this rejection has been overcome and respectfully requests that it be withdrawn.

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### **EXTENSION OF TIME REQUEST**

Applicant hereby requests a one-month Extension of Time. Payment for the Extension will be effected at the time of electronic filing.

### **CONCLUSION**

Applicant believes that the rejections have been overcome for the reasons recited above. Therefore, Applicant respectfully requests that all remaining claims be allowed and that a timely Notice of Allowance be issued.

No addition fees are believed due. However, the Commissioner is hereby authorized to charge any additional fees that may be required, including any necessary extensions of time, which are hereby requested, to Deposit Account No. 503535.

08/17/2009

Date



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